

37. (New) The method according to claim 35, further comprising allowing the user to adjust at least one of the indicator levels at least one level on the predetermined scale associated with that indicator.

38. (New) The method according to claim 35, further comprising storing the answers to the questions.

39. (New) The method according to claim 35, further comprising:
asking at least one background information question regarding the patient to the individual, and

receiving an answer for each of the at least one background information question from the individual.

40. (New) The method according to claim 35, further comprising providing educational material about asthma.--

REMARKS

Reconsideration of the Office Action of October 10, 2002 respectfully is requested. This Amendment is in response to that Office Action. This Amendment is being concurrently filed with a one month extension of time.

I. Discussion of Amendments

Attached hereto is a marked-up version of the changes made to the claims by the current Amendment. The attachment is captioned "Version with markings to show changes made."

Claims 5, 10, 11, 16, 21, and 22 have been amended in this Amendment. Claims 5, 10, 11, 21, and 22 have been amended to improve the clarity of the claim in view of the indefiniteness rejection. Claim 16 has been amended in two places. The first change added "that make up the assessment" to the end of step d, which Applicants submit was inherent in the claim as originally filed and thus is not a narrowing amendment. The second change was the addition of a wherein clause to further define the invention recited in claim 16.

Claims 29-34 have been cancelled without prejudice. New claims 35-40 have been added in this Amendment. No additional claim fees are required as the number of added claims equals the number of cancelled claims in. The new claims are directed at a method as defined by the invention with the independent claim 35 being based in part on what is shown in Figures 5-8. The new dependent claims have recitations similar to some of the originally filed dependent claims.

After this amendment, claims 1-28 and 35-40 are pending in this application.

II. Drawing Objection

Figures 9(a), 9(b), and 10 have been objected to because the margins are not sufficient. The objection is submitted as being moot in view of the concurrently filed Formal Drawing Transmittal, and as such Applicants respectfully request that this objection be withdrawn.

III. 35 U.S.C. §112, second paragraph, rejections

Claims 5, 10, and 21 have been rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully submit that this objection is moot with the amendment of these claims in a manner as proposed during the December 18, 2002 interview. These claims have been amended to recite "means for providing educational material to the user regarding asthma" and "providing educational material to the user regarding asthma," respectively.

Claim 11 has been rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for its dependency from claim 10. Applicants respectfully submit that this rejection is overcome because of the amendment to claim 10 and the amendment to claim 11 to change "educating" to "providing education material."

Claim 22 has been rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for its dependency from claim 21. Applicants respectfully submit that this rejection is overcome because of the amendment to claim 21 and the amendment to claim 22 to change "educating" to "providing education material."

Applicants respectfully request that this rejection be withdrawn.

IV. 35 U.S.C. §102(e) rejection

Claims 1, 4-8, 10, 12-18, 20-31 and 33-34 have been rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Finkelstein (U.S. Patent No. 6,283,923). Applicants respectfully traverse this rejection.

35 U.S.C. §102 by its language requires that each and every element of a claim be present in a single cited reference to properly have that reference anticipate that claim. See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566, 1567 (Fed. Cir. 1992), *citing Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988), *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984); *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992), *Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571, 36 USPQ2d 1417, 1419 (Fed. Cir. 1995).

a. Claims 1, 4, and 5

Claims 1, 4, and 5 use means-plus-function language to recite the elements that are included within "a system for scoring an asthma survey for a patient based on information entered by a user regarding the patient." Claim 1. Means-plus-function language is examined to encompass the "broadest reasonable interpretation" within the constraints of 35 U.S.C. §112, sixth paragraph. See *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845 (Fed. Cir. 1994)(in banc). The U.S. Patent & Trademark Office "may not may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination. *Id.*; *In re Graves*, 69 F.3d 1147, 36 USPQ2d 1550 (Fed. Cir. 1997).

Claim 1 recites a "means for questioning the user regarding the patient" that the specification discloses as including asking a series (or set) of questions of the user regarding the patient during one setting. See, e.g., published specification paragraphs 60-73,¹ Figures 5-8. Claim 1 also recites a "means for accumulating a score for at least one indicator based on answers entered by the user to the questions" as discussed, for

¹ Reference to paragraph numbers will be to the numbering used in the published patent application (US 2001/0055750 A1).

example, in connection with step 840 in paragraph 54 and illustrated by the score blocks in Figures 5-8.

On the other hand, Finkelstein appears to disclose asking individual questions on a variety of topics as illustrated as region 340 in Figure 3. Finkelstein, col. 8, lines 54-57. Finkelstein goes on to state that “[e]ach answer is graded according to a predetermined scale, usually 0 to 3. For example, wheezing is graded as 0 (none, no wheezing), 1 (mild wheezing), 2 (moderate wheezing), or 3 (severe wheezing).” Col. 8, lines 57-60. The fundamental difference is that Finkelstein discloses setting a textual level to an individual symptom, but not combining answers to a set of conditions to produce a textual level for a set of conditions. Finkelstein’s compiling of scores for a particular symptom over a period of days does not anticipate the accumulating means, because the compilation of scores in Finkelstein is for individual symptoms and there is no disclosure of combining symptoms to determine, for example, a severity level, compliance level, and performance level based upon a set of answers to a set of questions.

Claim 1 then concludes by reciting a “means for informing the user of the at least one indicator level from said correlating means” and this is discussed, for example, in connection with step 870 in paragraph 55. The Office Action cites col. 3, lines 40-43 of Finkelstein to anticipate the informing means; however, this reliance appears to be misplaced since the citation discusses displaying the information remote from the person who entered the information, which in Finkelstein is the patient. Displaying information remote from the patient who is the user is unable to anticipate the recited “means for informing the user.”

For these reasons, Applicants respectfully submit that Applicants respectfully submit that claim 1 is patentable over Finkelstein, because Finkelstein does not disclose each and every element of each of these claims. With respect to claims 4 and 5, Applicants respectfully submit that dependent claims, by definition, include all the limitations of the claims from which they depend, and thus cannot be anticipated if a parent claim is not. See 35 U.S.C. §112(4).

b. Claims 6-8, 10, and 12-15

Claim 6 recites that for each question in an assessment, "incrementing a score for at least one indicator based on the answer to the question." Finkelstein discloses grading the answer to a diary question against a scale (col. 8, lines 53-60), and does not disclose the incrementing step as there is no reason to perform such a step in the Finkelstein invention since each diary question is graded individually thus there is no need to increment a indicator score based on the answer to a question as recited in claim 6.

Claim 7 depends from claim 6 and further recites "informing the user of the at least one indicator level." The relied upon portion of Finkelstein discloses only that the information is provided to someone remote from the user, i.e., the patient, and thus the patient is not informed of rating of their answers to diary questions. Col. 3, lines 17-20, 41-43 ("displaying the test results, response message and patient information at a remotely located diagnosis/evaluation station").

Claim 8 recites "allowing the user to adjust at least one indicator level by at least one level." The relied upon dynamically modified alert conditions of Finkelstein appears to be misplaced, since the "[a]lert parameters can be preset for any of the twenty-nine FVC test parameters." Col. 7, lines 7-14. The Finkelstein alert parameters relate to alerting a medical professional of a problem based upon real physical test data obtained from a FVC test, not answers to symptom diary questions, which disclosure is relied upon in rejecting the claims from which claim 8 depends.

Based upon the above, Applicants respectfully submit that claims 6-8 are patentable over Finkelstein, because Finkelstein does not disclose each and every element of each of these claims. Applicants respectfully submit that dependent claims 7, 8, 10, and 12-15, by definition, include all the limitations of the claims from which they depend, and thus cannot be anticipated if a parent claim is not. See 35 U.S.C. §112(4).

c. Claims 16-18 and 20-26

Claim 16 recites "repeating steps a through c [asking a question, receiving an answer, and accumulating a score] for each question in a series of questions that make up the assessment." Claim 16 also recites that "for each of the at least one indicator,

there is at least answers to two questions that will result in the indicator." During the interview, the Examiner indicated he understood Finkelstein to teach the accumulation of several days worth of answers to individual symptom diary questions, with each answer having its on rating as discussed in col. 8, lines 53-60 and illustrated as region 340 in Figure 3. Finkelstein, however, does not teach the combining of answers to different questions to come up with a grade according to a predetermined scale. Therefore, Finkelstein is unable to anticipate claim 16. Applicants respectfully submit that dependent claims 17, 18, and 20-26 are also patentable, because, by definition, they each include all the limitations of the claims from which they depend, and thus cannot be anticipated if a parent claim is not. See 35 U.S.C. §112(4).

d. Claims 29-31, 33, and 34

The rejection of claims 29-31, 33, and 34 is moot with their cancellation.

Applicants respectfully request that this rejection be withdrawn.

V. 35 U.S.C. §103(a) rejections

a. Claims 9 and 19

Claims 9 and 19 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Finkelstein. Applicants respectfully traverse this rejection.

Claim 9 recites that "the at least one indicator includes at least one of a severity level, a compliance level, and a performance level." Claim 9 depends from claim 7 which in turn depends from claim 6 which recites that an answer to a particular question increments a score for at least one indicator. Finkelstein discloses classifying a peak expiratory flow test result per guidelines established by the National Heart, Lung, and Blood Institute. Col. 6, lines 16-20. The peak expiratory flow test is a test to determine a physical characteristic of the patient, and does not include the patient answering any questions. The classification in Finkelstein is based upon a physical characteristic and not an answer to a question. The communication provided by the physician relates to the physician analysis of physical test results, and not entries made by the patient in response to the symptom diary questions. Col. 7, lines 21-37. The Office Action fails to offer an explanation as to why one of ordinary skill in the art would take this teaching

and apply it to analyzing answers to questions about a patient. Applicants respectfully submit that claim 9 is patentable over Finkelstein.

Applicants respectfully submit that claims 9 and 19 are patentable over Finkelstein in view of their dependence from claims submitted to be patentable over Finkelstein. See 35 U.S.C. §112(4). Applicants respectfully request that this rejection being withdrawn.

b. Claims 2 and 3

Claims 2 and 3 have been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Finkelstein in view of Brown (U.S. Patent No. 5,879,163). Applicants respectfully traverse this rejection.

As discussed above, Applicants respectfully submit that claim 1 is patentable over Finkelstein. Applicants respectfully submit that Brown '163 does not teach or suggest the recited means-plus-function in claim 1. Therefore, the combination of Finkelstein and Brown '163 would be unable to teach or suggest claim 1. Claims 2 and 3 depend from claim 1, and therefore are submitted to also be patentable over the combination of Finkelstein and Brown '163. See 35 U.S.C. §112(4).

Additionally, as discussed above in connection to claim 9, Finkelstein does not teach or suggest that the "indicators include severity level, compliance level, and performance level" as recited in claim 3.

Applicants respectfully request that this rejection be withdrawn.

c. Claims 11 and 32

Claims 11 and 32 have been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Finkelstein in view of Brown (U.S. Patent No. 6,375,469). Applicants respectfully traverse this rejection with respect to claim 11, and submit that this rejection is moot with respect to claim 32. Applicants respectfully submit that claim 11 is patentable over this combination in view of its dependency from patentable claim 6 through claims 7 and 10, because Brown '469 does not rectify the missing teachings of Finkelstein. Applicants respectfully request that this rejection be withdrawn.

VI. Interview Summary

Applicants concur in the contents of the Interview Summary for the December 18, 2002 interview with the comments below and as reference to the interview above. Applicants believe agreement was reached as to how to address the 35 U.S.C. §112, second paragraph, rejections. A CD having the software that was demonstrated was left with the Examiner at the conclusion of the interview. Applicants would like to thank the Examiner and the Primary Examiner for preparing and participating in the interview.

In view of the above amendments and Remarks, it courteously is urged that all the claims are allowable and that the application now is in condition for allowance. If the Examiner believes that the prosecution could be advanced through a telephone conversation, then the Examiner is invited to telephone the undersigned. Favorable action in this regard earnestly is solicited.

Respectfully submitted,
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"Version with markings to show changes made"

5. (Amended) The system according to claim 1, further comprising means for educatingproviding educational material to the user regarding asthma.

10. (Amended) The method according to claim 7, further comprising educatingproviding educational material to the user regarding asthma.

11. (Amended) The method according to claim 10, wherein educatingproviding educational material includes showing multimedia presentations to the user.

16. (Amended) A method for assessing severity of asthma for a patient comprising:

- a) transmitting a question to an individual,
- b) receiving an answer to the transmitted question from the individual,
- c) accumulating a score for at least one indicator based upon the received answer,
- d) repeating steps a through c for each question in a series of questions that make up the assessment, and
- e) transmitting at least one indicator level based on the at least one indicator score to the individual; and

wherein for each of the at least one indicator, there is at least answers to two questions that will result in the indicator.

21. (Amended) The method according to claim 16 further comprising educatingproviding educational material to the user about asthma.

22. (Amended) The method according to claim 21, wherein the educatingproviding educational material step includes material tailored to the at least one indicator level of the patient.

--35. (New) A method for assessing the severity of asthma for a patient comprising:

setting a score for at least two indicators to zero,

asking a plurality of questions,

for each answer to one of said questions, adjusting the score for at least one indicator where said indicator is predetermined to relate to the question for which the answer was provided,

determining an indicator level for each indicator based on comparing that indicator to a predetermined scale, and

providing the indicator level for each indicator.

36. (New) The method according to claim 35, wherein the at least two indicators include at least one of a severity level, a compliance level, and a performance level.

37. (New) The method according to claim 35, further comprising allowing the user to adjust at least one of the indicator levels at least one level on the predetermined scale associated with that indicator.

38. (New) The method according to claim 35, further comprising storing the indicator levels.

39. (New) The method according to claim 35, further comprising storing the answers to the questions.

40. (New) The method according to claim 35, further comprising:

asking at least one background information question regarding the patient to the individual, and

receiving an answer for each of the at least one background information question from the individual.

41. (New) The method according to claim 35, further comprising providing educational material about asthma.--